REMARKS

Applicant is canceling claims 8 and 9, without prejudice. Therefore, claims 1-7 currently are pending in the above-captioned patent application and are subject to examination. Reconsideration of the above-captioned patent application is respectfully requested in view of the foregoing amendments and the following remarks.

In the Office Action mailed April 26, 2004, the Examiner provisionally rejected claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over each of U.S. Patent No. 6,477,526 to Hayashi *et al.* ("Hayashi") and U.S. Patent No. 6,532,475 to Nakano *et al.* ("Nakano"). The Examiner also rejected claims 1-9 under 35 U.S.C. § 103(a), as being rendered obvious by U.S. Patent No. 6,263,343 to Hirono in view of U.S. Patent No. 5,948,040 to DeLorme *et al.* ("DeLorme"). Applicant respectfully traverses these rejections.

1. Double Patenting Rejections

The Examiner provisionally rejected claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over each of Hayashi and Nakano. Applicant respectfully disagrees.

Specifically, each of Hayashi and Nakano are related to a map information providing system for route calculation, and neither of these patents disclose or suggest a map database site equipped with a database which is configured to perform the functions performed by Applicant's claimed retrieval database. Therefore, Applicants respectfully request that the Examiner withdraw the double patenting rejections.

2. 35 U.S.C. § 103(a)

The Examiner rejected claims 1-9 under as being rendered obvious by Hirono in view of DeLorme. In order for the Examiner to establish a prima facie case for obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as the Examiner proposes. Second, there must be a reasonable expectation of success in connection with the Examiner's proposed combination of the references. And third, the prior art references must disclose or suggest all of the claim limitations. MPEP 2143 (emphasis added.) For the reasons set forth below, Applicants submit that the Examiner fails to establish a Prima Facie case for obviousness.

Applicant's independent claim 1 describes a map providing system comprising a "map-information providing site [which] has a map-information providing server for displaying the information providing screen for making the designation entry for the request to provide the map image to the information terminal," and a "map database site [which] has a map-information database storing map image data, [and] a retrieval database storing retrieval data for retrieving the map image data corresponding to said designation entry from said map-information database."

For example, as set forth in dependent claim 2, the retrieval data stored in the retrieval database may comprise "position data representing the correspondence between the designation entry translated into said required information form and

coordinates on a map, and data representing the correspondence between the position data and the map image data stored in said map-information database." Specifically, as set forth in Applicant's Description of Related Art section, one problem with the related art is that "when a corporation or the like managing a map-information providing site opens up its new shop or relocates its existing shop, the need for providing map information in accordance with the new position data arises." Appl'n, Page 4, Lines 17-21. "In [the related art], the corporation must update the position information database of the map-information providing site as occasion demands. *Id.* at Lines 21-24. "In consequence, there is a disadvantage the corporation or the like managing the map-information providing site bears the significant burden of the updating operation." *Id.* at Lines 25-27. In the present invention, in order to address this problem, the map database site and not the map-information providing site stores the retrieval data for retrieving the map image data corresponding to the designation entry from the map-information database. Moreover, in the present invention, a first site, i.e., the map-information providing site, displays the information providing screen to the user, and a second site, i.e., the map database site, comprises the retrieval database storing retrieval data for retrieving the map image data corresponding to the user's designation entry from the map-information database.

The Examiner alleges that Hirono discloses or suggests a map providing system comprising a "map-information providing site [which] has a map-information providing server for displaying the information providing screen for making the designation entry for the request to provide the map image to the information terminal," and a "map

database site [which] has a map-information database storing map image data, [and] a retrieval database storing retrieval data for retrieving the map image data corresponding to said designation entry from said map-information database," as set forth in independent claim 1. Applicant respectfully disagrees with the Examiner's characterization of the map providing system described in Hirono.

Specifically, Hirono discloses a map providing system which comprises a map data base center 1. "The map data base center 1 is provided with a server 11 connected to the Internet 10." Hirono, Column 4, Lines 1 and 2. "The server 11 stores map data corresponding to position data such as latitude and longitude." *Id.* at Lines 2-4. "The map data stored in the server 11 is constantly updated to correspond with constantly changing map data." *Id.* at lines 4-6. "Desired map data may be obtained by accessing the WWW site of the map data in this map data base center 1." *Id.* at Lines 6-8.

The map providing system described in Hirono also comprises a position data base center 2. "The position data base center 2 manages a WWW site for searching the position of a shop or event venue." *Id.* at Lines 30-32. "The position data base 2 has a server 12." *Id.* at Lines 32 and 33. "This server 12 stores a data base for searching, for example, latitude/longitude data corresponding to addresses, main building names and shop names, and latitude/longitude data for event venues." *Id.* at Lines 33-36. "When the WWW site of the center 2 is accessed, and for example addresses are input, latitude/longitude data can be retrieved." *Id.* at Lines 39-41. "Searches wherein maps are directly displayed may also be performed by linking the

WWW site of the position data base center 2 and the WWW site of the map data base center 1." *Id.* at Lines 48-51 "For example, assume the user wishes to know the location of a shop which meets predetermined conditions, in this case, the user opens the WWW site managed by the position data base center 2 using the browser of the terminal 15." *Id.* at Lines 52-55. "When the site of the center 2 is opened, data is sent from the site of the center 2 to the terminal 15, and the position search WWW page is displayed on the screen of the terminal 15, as shown in FIG. 3A." *Id.* at Lines 56-59. "The user enters the required items on the search page." *Id.* at Lines 59 and 60. "When the required items are entered, latitude/longitude data for the positions of shops which meet the conditions is searched based on the items entered by the server 12 of the center 2." *Id.* at Lines 60-63. "Retrieved latitude/longitude data is sent to the map data base center 1, . . . [and] map data corresponding to this position is searched from map data stored in the server 11." *Id.* at Lines 63-66. "This map data is linked to the position search WWW page, and a map of the input shop is thereby displayed on the screen of the terminal 15 as shown in FIG. 3B." *Id* at Lines 66 and 67; and Column 5, Lines 1 and 2.

Thus, position data center 2 displays an information providing screen to the user, and in response to information which the user inputs via the information providing screen, position data center 2 also retrieves the associated latitude/longitude data from its own database. Position data center 2 then transmits the associated latitude/longitude data to map data base 1, and map data base 1 retrieves the map data corresponding to the associated latitude/longitude data and displays the map data to the

user.

Applicant notes that map data base 1 cannot correspond to Applicant's claimed "map-information providing site" because map data base 1 does not display an information providing screen, as set forth in independent claim 1. Specifically, position data center 2 displays the information providing screen to the user. See, e.g., Hirono, Column 4, Lines 56-59. However, in contrast to Applicant's claimed invention, in Hirono, the same site, i.e., the site associated with position data center 2, displays the information providing screen and searches its own database for the data corresponding to Applicant's claimed retrieval data. Position data center 2 then transmits the retrieval data to map data base 1, and map data base 1 uses the retrieval data from to retrieve the map image data corresponding to the designation entry from position data center 2. Thus, Hirono fails to disclose or suggest a map providing system comprising a "map-information providing site [which] has a map-information providing server for displaying the information providing screen for making the designation entry for the request to provide the map image to the information terminal," and a "map database site [which] has a map-information database storing map image data, [and] a retrieval database storing retrieval data for retrieving the map image data corresponding to said designation entry from said map-information database," as set forth in independent claim 1. Moreover, the Examiner does not allege that DeLorme discloses or suggests these missing limitations.

In addition, the Examiner acknowledges that Hirono does not disclose or suggest "a map server for comparing said designation entry made on said information providing

screen with said retrieval database to read out the map image data corresponding to the designation entry from said map-information database, and sending the read-out map image to the information terminal," as set forth in independent claim 1. However, the Examiner asserts that DeLorme supplies this missing element. Applicant respectfully disagrees.

Specifically, Delorme is related to a system which performs travel planning, such as a system which allows a user to conduct a route search and to make a ticket reservation via a computer. However, the TRIPS facility described in Delorme does not do each of search a position data corresponding to a user's entry, read out a map image data corresponding to the position data, and display a map image on an information terminal. As such, the TRIPS facility cannot correspond to Applicant's claimed map server. Therefore, Applicant respectfully requests that the Examiner withdraw the obviousness rejection of independent claim 1.

Claims 2-7 depend from allowable independent claim 1. Therefore, Applicants respectfully request that the Examiner also withdraw the obviousness rejection of claims 2-7.

Applicant has canceled original claims 8 and 9, without prejudice. Therefore, the obviousness rejection of original claims 8 and 9 is rendered moot.

CONCLUSION

Applicant respectfully submits that the above-captioned patent application is in condition for allowance, and such action is earnestly solicited. If the Examiner believes that an in-person or telephonic interview with Applicant's representatives would expedite the prosecution of the above-captioned patent application, the Examiner is invited to contact the undersigned attorney of records. Applicant is enclosing a Petition for a One-Month Extension of Time to respond, and a check in the amount of $110 covering the requisite large entity fee for such extension of time, with this response. Nevertheless, in the event of any variance between the fees determined by Applicants and those determined by the U.S. Patent and Trademark Office, please charge any such variance to the undersigned's Deposit Account No. 01-2300.

Respectfully submitted,

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